

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Zaki et al.

Group Art Unit: 1796

Serial No.: 10/791,427

Examiner: Del Cotto, Gregory R.

Filed: March 2, 2004

Docket No.: 1456/3

Confirmation No.: 3775

For: SOLVENT COMPOSITIONS FOR REMOVING PETROLEUM RESIDUE FROM  
A SUBSTRATE AND METHODS OF USE THEREOF

\* \* \* \* \*

APPLICANT'S STATEMENT IN SUPPORT OF THE  
PRE-APPEAL BRIEF REQUEST FOR REVIEW

INTRODUCTION

Claims 1-42 and 105-135 are pending and have been rejected under 35 U.S.C. § 103(a) upon the contention that the claims are unpatentable over U.S. Patent No. 6,281,189 to Heimann et al. (hereinafter "Heimann") in view of U.S. Patent Application Publication No. 2003/0213747 of Carbonell et al. (hereinafter "Carbonell"); U.S. Patent No. 5,143,639 to Krawack et al. (hereinafter "Krawack"); Krawack in view of Carbonell and further in view of Heimann; U.S. Patent Application Serial No. 5,413,729 to Gaul et al. (hereinafter "Gaul"); Gaul in view of Heimann, U.S. Patent No. 5,421,907 to Nieendick et al. (hereinafter "Nieendick"), or U.S. Patent No. 5,194,173 to Folkard et al. (hereinafter "Folkard"); Gaul in view of U.S. Patent No. 6,030,466 to Myers, II (hereinafter "Myers, II"); and/or Gaul in view of Carbonell. Claims 1-19, 21-28, 33-43, 105-122, 124-126, and 129-135 have also been rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 7,547,672 to Zaki (hereinafter "Zaki") in view of Carbonell. Applicant respectfully submits that the pending rejections are not supported by any combination of Heimann, Carbonell, Krawack, Gaul, Nieendick, Folkard, Myers, II, and Zaki, as set forth in more detail herein below.

REMARKS – Rejections under 35 U.S.C. § 103(a)

According to the United States Patent and Trademark Office (hereinafter "the Patent Office"), Heimann teaches a composition containing at least one soybean oil derived compound and at least one member chosen from the group of drying agent(s), co-solvents, and additives, and that the composition can comprise methyl soyate and d-limonene. The Patent Office further asserts that the composition of Heimann contains from 0.5 to 20% by weight of at least one drying agent, about 1 to about 30% by weight of at least one co-solvent, additives from 0 to about 25% by weight, and 5 to 75% by weight of methyl soyate. The Patent Office further asserts that Heimann teaches that suitable additives include surfactants (e.g. anionic and nonionic), emulsifiers, antimicrobial compounds, etc., and that suitable co-solvents include water, hydrocarbon glycols, and mixtures thereof among others. The Patent Office further asserts that Heimann teaches that additives may be added to the compositions including dipropylene glycol n-butyl ether (butyl carbitol), and that the inventive composition disclosed therein can be employed as a general purpose cleaner, parts cleaner, engine degreaser, tar and asphalt remover, printing press cleaner, metal cleaner, etc.

The Patent Office acknowledges that Heimann does not teach the use of a benzoic acid ester or a composition having the specific physical parameters containing a benzoic acid ester, methyl soyate, nonionic surfactant, water, and the other requisite components of the composition in the specific amounts as recited by the instant claims. The Patent Office asserts that Carbonell cures these deficiencies by teaching environmentally friendly solvents such as benzoic acid esters.

Applicants respectfully disagree. Particularly, applicants respectfully submit that the Patent Office is not considering the claimed subject matter or the cited references in their entireties as required by M.P.E.P. § 2141.02.

To elaborate, claim 1 recites *inter alia* a water-soluble composition for removing petroleum residue from a substrate, said composition comprising (a) from about 10% to about 60% by weight of an aromatic ester; (b) from about 30% to about 60% by weight of an aliphatic ester; and (c) from 0% to about 15% by weight of a co-solvent. Claims 105, 108, and 110 recite additional embodiments that include narrower ranges for one or more of the components and/or additional characteristics thereof. Heimann is

asserted to teach methyl soyate as an aliphatic ester, and as set forth in claim 13 of Heimann, it can comprise 5-75% of the composition. Carbonell, on the other hand, discloses that, "Preferably, in various embodiments, the benzoic acid ester-containing solvent contains at least about 70, 80, 85, 90, 95, or 99 percent by weight of the one or more benzoic acid esters" (see Carbonell at [0039], [0050], and claims 8, 22, 31, 34, 37, 40, 43, 46, 55, 68, 71, 74, 77, 80, 83, 89, 100, 103, 106, 109, 12, and 115). Applicants respectfully submit that there is no disclosure in Carbonell that would have led one of ordinary skill in the art to employ from about 10% to about 60% by weight of an aromatic ester as recited in instant claims 1 and 110, and particularly the ranges for the aromatic and aliphatic esters recited in claims 105 and 108, and thus the Patent Office is believed to have selected from Carbonell only so much of the reference as can be used to support its asserted position. Applicants respectfully submit that this approach is clearly improper under M.P.E.P. § 2141.02 and also *In re Wesslau*, 53 C.C.P.A. 746, 353 F.2d 238, 241 (1965) ("It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art."). Given that each and every element of a claim must be considered, the Patent Office has provided no basis for concluding that the specific ranges cited in independent claims 1, 105, 108, and 110 would be obvious to one of ordinary skill in the art.

Applicants respectfully submit that a similar approach has been taken in all of the other rejections. Krawack substitutes for Heimann in allegedly disclosing aliphatic esters, Gaul allegedly discloses esters plus lactones, Nieendick allegedly discloses 2-ethylhexyl aliphatic esters, Folkard allegedly discloses aliphatic esters, and Myers, II allegedly discloses surfactants and fragrances. Applicants respectfully submit that it is apparent that the Patent Office has merely identified references that teach exemplary aliphatic esters, aromatic esters, surfactants, or fragrances, but in no case do any of the cited references, either alone or in combination, disclose or suggest combinations of the aliphatic and aromatic esters in the amounts recited in the instant claims. As such, applicants respectfully submit that a *prima facie* case of obviousness of claims 1-42 and 105-135 has not been presented with respect to any of the combinations recited by the

Patent Office as none of these references discloses or suggests each and every element of the instant claims.

Furthermore, applicants respectfully submit that the instantly claimed compositions are believed to have unexpectedly superior properties as compared to the compositions of the cited art. Applicants respectfully submit that a Rule 132 Declaration was filed on December 23, 2008 by co-inventor Dr. Robert Troxler (hereinafter "the Troxler Declaration"). In the Troxler Declaration, the presently claimed compositions were shown to be vastly superior to compositions consisting of an aliphatic ester alone (e.g., methyl soyate) or an aromatic ester alone (isopropyl benzoic acid ester; IPB) at dissolving asphalt. Additionally, the combination of an aliphatic ester and an aromatic ester as claimed in the instant application provides much better than additive results vis-à-vis an aliphatic ester and an aromatic ester individually as set forth in Points 8 and 9 of the Troxler Declaration and in the specification as filed, including particularly in Table 2 at page 30.

Thus, applicants respectfully submit that the evidence of the superior properties of the instantly claimed compositions provided in the Troxler Declaration and in Table 2 of the instant specification is believed to rebut the Patent Office's asserted *prima facie* case. As a result, applicants respectfully submit that Heimann, Carbonell, Krawack, Gaul, Nieendick, Folkard, and Myers, II, alone or in any combination, fail to support the instant rejections of claims 1-42 and 105-135 under 35 U.S.C. § 103(a), and thus these rejections should be withdrawn at this time.

#### REMARKS – Obviousness-type Double Patenting Rejections

With respect to the obviousness-type double patenting rejection of claim 1-19, 21-28, 33-43, 105-122, 124-126, and 129-135 over Zaki in view of Carbonell, applicants respectfully submit that the above comments are equally applicable to this rejection. Applicants respectfully submit the Patent Office acknowledges that Zaki does not suggest the use of an aromatic ester, and Carbonell does not suggest using less than 70% aromatic ester in any composition.

As such, applicants respectfully submit that a complete consideration of both the claims and the cited references in their entireties demonstrates that the combination of

Zaki and Carbonell fails to support a *prima facie* case of obviousness of claims 1-19, 21-28, 33-43, 105-122, 124-126, and 129-135 under 35 U.S.C. §103(a).

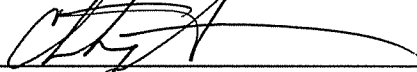
And finally, applicants respectfully submit that the subject matter of claims 1-19, 21-28, 33-43, 105-122, 124-126, and 129-135 is characterized by unexpectedly superior properties over those disclosed in Zaki and Carbonell. Thus, even if the Patent Office had made out its *prima facie* case, it would have been rebutted by the data provided in the Troxler Declaration and in the specification as filed, including particularly the data presented in Table 2 at page 30.

Accordingly, applicants respectfully submit that claims 1-42 and 105-135 are in condition for allowance, and respectfully solicit a Notice of Allowance to that effect.

The Commissioner is hereby authorized to charge any deficiencies or credit any overpayments associated with the filing of this correspondence to Deposit Account Number 50-0426.

Respectfully submitted,

JENKINS, WILSON, TAYLOR & HUNT, P.A.

Date: January 28, 2011 By:   
Christopher P. Perkins  
Registration No. 52,111  
Customer No. 25297  
(919) 493-8000

1456/3 CPP/dbp